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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,242	03/08/2004	Li Gong	13909-145001 / 2003P00563	2176
32864 7590 03/10/2008 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER ALBERTALLI, BRIAN LOUIS	
			ART UNIT 2626	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/796,242

**Applicant(s)**

GONG ET AL.

**Examiner**

BRIAN L. ALBERTALLI

**Art Unit**

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10-18 are directed to "A computer program product, tangibly embodied in an information carrier..." However, the specification (page 12) explicitly includes "a propagated signal" as an example of a computer program tangibly embodied in an information carrier. A "signal", as a form of energy, is not patentable subject matter because it does not fall within one of the four categories of invention.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-14, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ostermann et al. (U.S. Patent 6,963,839).

In regard to claim 1, Ostermann et al. disclose a system (Fig. 4A), comprising:

a speech animation engine (animation server 68, column 5, lines 7-12); and  
a client application in communication with the speech animation engine (client application 64, column 4, lines 54-59),

wherein the client application is operable to perform the following operations:

    sending a request for speech animation to the speech animation engine, the request identifying data to be used to generate the speech animation (text with emoticons and other parameters is sent to animation server 68 to generate an animation that matches the text, column 5, lines 7-26), the speech animation being speech synchronized with facial expressions (animated characters are generated that appear to speak the submitted text message, column 5, lines 26-36);

    receiving a response from the speech animation engine, the response identifying the generated speech animation (the animated message is returned to the client, column 5, lines 37-52; by pointing to the appropriate location, column 7, lines 5-13); and

    using the generated speech animation to animate a talking agent displayed on a user interface of the client application (the animated message is displayed to the client for viewing, column 7, lines 8-13);

and wherein the speech animation engine is operable to perform the following operations:

    receiving the request for speech animation from the client application (animation server 68 receives the sender message, column 5, lines 7-17);

retrieving the data identified in the request without user intervention (the animation server 68 processes the received sender message without intervention, column 5, lines 18-22);

generating the speech animation using the retrieved data (the sender message is used to generate an animated message, column 5, lines 22-26); and

sending the response identifying the generated speech animation to the client application (the animated message is returned to the client, column 5, lines 37-52; by pointing to the appropriate location, column 7, lines 5-13).

In regard to claim 2, Ostermann et al. disclose retrieving the data includes retrieving the data in real time (messages are processed in real time, column 6, lines 37-59).

In regard to claim 3, Ostermann et al. disclose the data specifies text to be used to generated the speech animation (text with emoticons and other parameters is sent to animation server 68 to generate an animation that matches the text, column 5, lines 7-26).

In regard to claim 4, Ostermann et al. disclose the text includes variable elements (emoticons and other parameters, column 5, lines 7-26).

In regard to claim 5, Ostermann et al. disclose the data specifies a voice to be used to generate the speech animation (the user selects a voice to be used, column 8, line 59 to column 9, line 6).

In regard to claim 7, Ostermann et al. disclose the request further identifies context information taken from a live session of the client application (during a live instant messaging session, context information about the user's identity is included, column 6, lines 60-65); and

generating the speech animation includes incorporating the context information into the generated speech animation (when participant send their message, the corresponding character is animated, column 6, line 65 to column 7, line 4).

In regard to claim 8, Ostermann et al. disclose the context information includes information about a user of the client application (the identity of the user, column 6, lines 60-65).

In regard to claim 9, Ostermann et al. disclose the client application is a web application (HTML client, column 4, lines 54-64); and

the request is an HTTP request (the request is sent over the Internet 62, thus the request must inherently be an HTTP request, column 5, lines 7-12).

In regard to claim 10, Ostermann et al. disclose a computer program product, tangibly embodied in an information carrier, the computer program product being operable to cause data processing apparatus to perform operations comprising:

receiving a request from a client application for speech animation, the request identifying data to be used to generate the speech animation, the speech animation being speech synchronized with facial expressions (text with emoticons and other parameters is sent to animation server 68 to generate an animation that matches the text, column 5, lines 7-26);

retrieving the data without user intervention (the animation server 68 processes the received sender message without intervention, column 5, lines 18-22);

generating the speech animation using the retrieved data (the sender message is used to generate an animated message, column 5, lines 22-26); and

sending a response identifying the generated speech animation to the client application (the animated message is returned to the client, column 5, lines 37-52; by pointing to the appropriate location, column 7, lines 5-13).

Claims 11-14 and 16-18 are identical in scope to claims 2-5 and 7-9, respectively, and thus are rejected for the same reasons as give above.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Ostermann et al., in view of Phillips (U.S. Patent 6,507,811).

In regard to claims 6 and 15, Ostermann et al. do not disclose the data specifies a pool of synonyms; and

generating the speech animation includes selecting a synonym from the pool of synonyms.

Phillips discloses a system and computer program product for generating messages, wherein a user:

specifies a pool of synonyms (a list of one or more synonyms, column 6, lines 49-58); and

selecting a synonym from the pool of synonyms (one of the list of synonyms is selected at random to be included in the message, column 6, lines 58-63).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Ostermann et al. to allow the user to specify a pool of synonyms and then select one of the synonyms during generation of the speech animation, because randomly selecting a synonym for inclusion in a message provides a highly amusing affect, as taught by Phillips et al. (see Abstract). Especially in the context of sending animated messages, one of ordinary skill in the art would be motivated to add features, such as selecting a synonym from a pool of synonyms, which would increase the amusement value of the animated messages.



***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nashida et al. (U.S. Patent Application Publication 2002/00105819), Wang et al. (U.S. Patent 7,085,259), and Cossatto et al. (U.S. Patent Application Publication 2004/0215460) disclose additional client/server based speech animation systems.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN L. ALBERTALLI whose telephone number is (571)272-7616. The examiner can normally be reached on Mon - Fri, 8:00 AM - 5:30 PM, every second Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (571) 272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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